

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

In re Application of:	:	Before the Examiner:
Chan et al.	:	Pouncil, Darnell A.
	:	
Serial No.: 10/773,496	:	Group Art Unit: 3688
	:	
Filing Date: February 6, 2004	:	
	:	
Title: MARKETING PROFILE	:	IBM Corporation
STORE	:	Dept. T81/Bldg. 503
	:	P.O. Box 12915
	:	3039 Cornwallis Road
	:	Research Triangle Park, NC 27709

REPLY BRIEF UNDER 37 C.F.R. §41.41

Mail Stop Appeal Brief - Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

This Reply Brief is being submitted in response to the Examiner's Answer dated May 29, 2009, with a two-month statutory period for response set to expire on July 29, 2009.

I. RESPONSE TO EXAMINER'S ARGUMENTS:

- A. Response to Examiner's assertion that claims 1-7 and 22 are properly rejected under 35 U.S.C. §101, as discussed on pages 3-4 of Examiner's Answer.

The Examiner has rejected claims 1-7 and 22 under 35 U.S.C. §101 because the claimed inventions are allegedly directed to non-statutory subject matter. Examiner's Answer, page 3. In particular, the Examiner states that the method/process claim must (1) be tied to a particular machine or apparatus or (2) transform a particular article into a different state or thing. *Id.* Appellants respectfully assert that independent method claim 1 is tied to a particular machine or apparatus and therefore satisfies the test laid out in *In re Bilski*.

The preamble of independent method claim 1 states:

For a client/server system having at least a client including a graphical user interface to display a content of virtual hosted stores to a user, the virtual stores being stored in databases managed by a database management system in a resource manager, the graphical user interface being operatively connected to an application server having a business logic module to select the content to be displayed, a method of managing the content of the hosted virtual stores comprising the steps of:

Claim 1 is clearly tied to a machine/apparatus by claiming a client to display the content of virtual hosted stores. The preamble states a client including a graphical user interface to display a content of virtual hosted stores to a user, the virtual stores being stored in databases managed by a database management system in a resource manager. Any terminology in the preamble that limits the structure of the claimed invention must be treated as a claim limitation. *Corning Glass Works v. Sumitomo Elec., U.S.A., Inc.*, 868 F.2d 1251, 1257, 9 U.S.P.Q.2d 1962, 1966 (Fed. Cir. 1989); M.P.E.P. §211.02. Hence, this language directed to a client to display the content of virtual hosted stores must be treated as a claim limitation. As further evidence that this language was treated as a claim limitation, the first limitation following the preamble recites "creating a profile store which serves as a template and upon which the hosted stores are formatted" thereby clearly referring to the hosted stores in the

preamble, whose content is displayed by a client, which is a machine/apparatus.

Therefore, since independent method claim 1 is tied to a particular machine or apparatus, claims 1-7 and 22 satisfy the test laid out in *In re Bilski*. Accordingly, claims 1-7 and 22 are directed to statutory subject matter and are not properly rejected under 35 U.S.C. §101.

B. Response to Examiner's assertion that a virtual store is not a hosted store, as discussed on pages 10-11 of Examiner's Answer.

The Examiner asserts that Appellants state that a virtual store is a hosted store but that there is no language in Appellants' Specification that supports such an interpretation. Examiner's Answer, page 10. Appellants though stated that virtual stores refer to an online store offering a compelling shopping experience and are based on a profile store. Appellants' Appeal Brief, page 7. Further, Appellants kindly direct the Board to at least page 5, lines 18-24; page 6, lines 5-6 and 15; and page 7, line 1 of Appellants' Specification where the phrase "virtual hosted store" and "virtual store" are used in tandem. Further, Appellants direct the Board's attention to at least page 3, lines 3-8 of Appellants' Specification which discusses a virtual store as being a hosted store selling products or services.

C. Response to Examiner's assertion that Westrope discloses "designating one or more e-marketing spots in the hosted stores" as recited in claim 1, as discussed on pages 11-12 of Examiner's Answer.

The Examiner cites page 9, lines 1-14¹ of Westrope as disclosing "designating one or more e-marketing spots in the hosted stores" as recited in claim 1. Examiner's Answer, pages 11-12. Appellants respectfully traverse the assertion that Westrope discloses the above-cited claim limitation.

¹ Appellants note that the language quoted by the Examiner on pages 11-12 of the Examiner's Answer is not directly quoted from page 9, lines 1-14 of Westrope as alleged by the Examiner. Instead, the language appears to be quoted from page 5, lines 10-14 of Westrope.

Westrope discloses that different docket templates may be required if the response fulfillment campaign uses different creative content for different advertisements (e.g., different media outlets having different creative requirements) or if the response options offered are different for different media licensees participating in the same-response fulfillment campaign. Page 5, lines 10-14. Hence, Westrope discloses using different creative content for different advertisements, such as different media outlets having different creative requirements.

There is no language in the cited passage that discloses designating one or more e-marketing spots in the hosted stores. Instead, Westrope discloses creating content for different advertisements for different media outlets. Media outlets refer to conventional media outlets, such as radio, television and billboards. See, e.g., page 2, lines 9-11 of Westrope.

Furthermore, the Examiner appears to equate "media outlets" with "hosted stores." Examiner's Answer, page 12. As discussed in Appellants' Appeal Brief (page 8), Westrope focuses on selecting media licensees which are conventional media channels, such as billboards, print, television, radio and packaging, as specifically discussed on page 2, lines 9-11 of Westrope. An embodiment of a hosted store is illustrated as element 310 in Figure 3 of Appellants' Specification. See, e.g., Appellants' Specification, page 12, lines 14-16. A hosted store is a virtual store as discussed at least in part on page 1, lines 17-22 of Appellants' Specification. Conventional media channels are not equivalent to hosted stores as alleged by the Examiner.

- D. Response to Examiner's assertion that Westrope teaches "accessing a list of pre-defined e-marketing spots for a profile store" as recited in claim 22, as discussed on page 15 of Examiner's Answer.

The Examiner cites page 9, lines 1-5 of Westrope as teaching "accessing a list of pre-defined e-marketing spots for a profile store" as recited in claim 22. Examiner's Answer, page 15. Appellants respectfully traverse.

Westrope teaches that the docket template interface 104 includes presentation layout templates 308 from which the creator can select. Page 9, lines 1-2. Westrope further teaches that the presentation layout templates 308 determine the layout of the electronic response boxes and the advertisements when they are displayed to the consumer. Page 9, lines 2-4.

Hence, Westrope teaches presentation layout templates that determine the layout of the electronic response boxes and the advertisements.

There is no language in the cited passage that teaches accessing a list. Neither is there any language in the cited passage that teaches accessing a list of pre-defined e-marketing spots. Instead, Westrope teaches a template for the layout of response boxes and advertisements. There is no discussion of a list of pre-defined e-marketing spots being accessed. Neither is there any language in the cited passage that teaches accessing a list of pre-defined e-marketing spots for a profile store.

Therefore, the cited passage does not teach the above-cited claim limitation as asserted by the Examiner.

- E. Response to Examiner's assertion that Westrope teaches "creating a campaign initiative for said hosted store by selecting said campaign initiative from said second list of campaign initiatives" as recited in claim 22, as discussed on page 16 of Examiner's Answer.

The Examiner asserts that Westrope teaches "creating a campaign initiative for said hosted store by selecting said campaign initiative from said second list of campaign initiatives" as recited in claim 22 based on the belief that there is no difference between a profile store and a hosted store. Examiner's Answer, page 16. Appellants respectfully assert that the Examiner is ignoring claim language. Appellants are claiming creating a campaign initiative for the hosted store by selecting the campaign initiative from a second list of campaign initiatives. The Examiner has not shown that either Westrope or Ozer teaches this aspect.

Furthermore, Appellants respectfully assert that there is a difference between a profile store and a hosted store. As stated above, a profile store serves as a template

and upon which the hosted stores are formatted. As further stated above, a hosted store is a virtual store selling products or services.

Accordingly, the Examiner has not shown that Westrope and Oz, taken singly or in combination, teach creating a campaign initiative for the hosted store by selecting the campaign initiative from the second list of campaign initiatives as recited in claim 22.

- F. Response to Examiner's assertion that Westrope teaches "scheduling said campaign initiative created for said hosted store to said e-marketing spot in said hosted store" as recited in claim 22, as discussed on page 16 of Examiner's Answer.

The Examiner cites page 6, lines 15-30 of Westrope as teaching "scheduling said campaign initiative created for said hosted store to said e-marketing spot in said hosted store" as recited in claim 22. Examiner's Answer, page 16. Appellants respectfully traverse.

Westrope teaches that when a creator, such as an advertiser or advertising agency, generates a new response fulfillment campaign, the system 100 may automatically generate a response campaign identification code that uniquely identifies a particular response fulfillment campaign 10. Page 6, lines 15-18. Westrope additionally teaches that the response fulfillment campaign interface provides fields 202 to allow the creator to enter specific details about the response fulfillment campaign into the system for storage in a system database. Page 6, lines 18-20. Furthermore, Westrope teaches that these details may include information about the advertiser and/or advertising agency designing the response fulfillment campaign, the response fulfillment campaign name 208, the advertiser's name 210, the brand name 214, product category 216, product type, product class 220, and the start and end dates/times of the campaign 224. Page 6, lines 20-27.

Hence, Westrope teaches generating a response campaign identification code that uniquely identifies a particular response fulfillment campaign. Further, Westrope teaches allowing the user to enter specific details (e.g., product type, product class,

start and end dates/times of campaign) about the response fulfillment campaign into the system for storage in a system database.

There is no language in the cited passage that teaches scheduling the campaign initiative created for the hosted store to the e-marketing spot in the hosted store. Instead, Westrope teaches allowing the user to enter the start and end dates/times of the campaign into the system.

Therefore, the cited passage does not teach the above-cited claim limitation as asserted by the Examiner.

G. Other matters raised by the Examiner.

All other matters raised by the Examiner have been adequately addressed above and in Appellants' Appeal Brief (3/24/2009) and therefore will not be addressed herein for the sake of brevity.

II. CONCLUSION:

For the reasons stated above and in Appellants' Appeal Brief (3/24/2009), Appellants respectfully assert that the rejections of claims 1-7 and 22 are in error. Appellants respectfully request reversal of the rejections and allowance of claims 1-7 and 22.

Respectfully submitted,

WINSTEAD P.C.

Attorneys for Appellants

By: 

Robert A. Voigt, Jr.
Reg. No. 47,159

P.O. Box 50784
Dallas, Texas 75201
(512) 370-2832

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